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TRANSMITTAL FORM

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		Application Number	09/328,120
		Filing Date	June 8, 1999
		First Named Inventor	Lovell
		Art Unit	3761
		Examiner Name	G. Dawson
Total Number of Pages in This Submission	19	Attorney Docket Number	SLP-005

ENCLOSURES *(check all that apply)*

- [ ] Fee Transmittal Form
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- [ ] Amendment / Reply
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- [ ] Affidavits/declaration(s)
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Paul C. Remus
Signature	
Date	May 24, 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application	:	Lovell, et al.	Art Unit	:	3761
Serial No.	:	09/328,120	Examiner	:	Dawson, G.
Filed	:	June 8, 1999	Docket No.:		SLP-005
Title	:	NOSE MASK			

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF PURSUANT TO 37 CFR 1.193(b)(1)

Subsequent to the Notice of Appeal filed August 18, 2003, Appellant filed a Brief dated October 20, 2003 ("Appellant's Brief"). Examiner then filed an Answer dated March 24, 2004 (the "Answer"). Appellant hereby submits a Reply Brief pursuant to 37 CFR 1.193(b)(1). This Reply Brief is submitted in triplicate.

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ARGUMENT

In rejecting all of the claims in the present Application, Examiner has relied, and continues to rely, on a single prior art reference U.S. Patent No. 3,725,953 to Johnson et al. (the "Johnson Patent"). The Johnson patent discloses a diver's mask having a resilient seal 20 "designed to accommodate differing facial features by including a suitably shaped layer of pliable neoprene 21 wrapped about and bonded onto a length of resilient surgical rubber tubing 22." Johnson patent, col. 2 , lines 42-45. The examiner contends that the pliable neoprene 21 is the bladder recited in claim 19 and the rubber tubing 22 is the molded material recited in claim 19. See Office action, page 3. The examiner further contends that the claimed durometer value of "less than about ten on a Shore 000 scale" and the other claimed limitations defining the shape and thickness are all considered to be "obvious design choices." Id.

Appellant first repeats one of the points submitted in Appellant's Brief not expressly addressed by Examiner in the Answer. Specifically, the modification required for the seal disclosed in the Johnson patent to meet the claimed durometer value is not the type of modification that should be deemed a mere "design choice." This is not merely a matter of changing the size or shape of an element or optimizing a range. See MPEP §2144.04 for examples. In order to meet the claimed durometer value, the Johnson Patent must be modified not only with a complete substitution of material (see Appellant's Brief, page 4) but also with a complete redesign. Examiner in addressing another point admits:

> "Therefore placing a tube 22 made out of material having the claimed durometer inside the tube 21 of Johnson would not provide a seal as a whole having the claimed durometer...i.e. the durometer of the seal of Johnson, once modified as the examiner contends, would have an overall seal of a durometer higher than that of only the material of tube 22."
> Answer, page 5

There is no suggestion or motivation in the Johnson Patent or in the knowledge generally available to one of ordinary skill in the art to make either such a substitution of material or such a redesign. Consequently, Examiner has failed to establish a prima facie case of obviousness.

Appellant now turns to the points expressly raised by Examiner in the Answer. Examiner, after assuming the durometer is a "design choice", argues it is an "obvious design choice," because it is "not solving..a stated problem..." Answer, page 4. Assuming arguendo that the durometer value is a design choice, it is not "obvious" because it does solve a stated problem. Examiner overlooks the following statement in the present Application:

> "Because nasal masks are often worn by persons in unmonitored environments for extended periods, such as in the home during sleep, the nasal mask should be comfortable to wear and conform well to the nasal area. If the mask is deemed too bulky, too heavy, or to fit poorly, the patient will either not wear the mask, wear the mask improperly, or only wear the mask occasionally when the discomfort associated with the respiratory condition exceeds the discomfort of wearing the mask."
> Specification, page 2, lines 1-6.

The problem to be solved is to design a mask to be used during periods of inactivity, such as during sleep, for which the discomfort of the respiratory condition exceeds the discomfort of wearing the mask. The softness of the material, i.e., the low durometer value, used in the present Application contributes to the requisite comfort. See Specification, page 4, lines 5-8 and page 7, lines 11-21. Examiner has again failed to establish a prima facie case of obviousness.

Examiner then argues that the Johnson Patent does not teach away from the proposed modification as Appellant submitted it did. Appellant had noted (see Appellant's Brief, page 6, line 1-12) that the Johnson Patent describes a diver's mask to be worn under water. The diver's mask includes pressure compensation holes 22a, which allow air to enter the tube 22. If these holes 22a are omitted or plugged, the tube 22 would collapse under increasing water pressure and the mask would lose its seal (see Johnson Patent, column 3, lines 36-37).
Appellant had also noted:

> If the pliable neoprene 21 were filled with a material having a durometer value less than about ten on a Shore 000 scale, as proposed by the examiner, the material having this durometer value would be soft enough

> to squeeze at least partially through the holes 22a. As a result, air would be prevented from passing through the holes 22a to compensate for changes in pressure, rendering the diver's mask unsatisfactory for the intended purpose stated in the Johnson Patent.
>
> Appellant's Brief, page 6, lines 5-9.

Examiner argues in the Answer:

> "The examiner is not maintaining that it would have been obvious to place a gel inside tube 21. The examiner maintains that it would have been obvious to have formed the tube 22 out of material within the claimed durometer. There would be no danger of the soft tube 22 being expelled out ports 22a as maintained by the applicant."
>
> Answer, page 4, lines 11-15

However, Examiner misses the point. A material within the specified durometer value is so soft that it would squeeze at least partially through the holes 22a. Whether the material is called a "gel" or a "tube" is not relevant. The fact that the material is so soft, regardless of the name affixed to it, that it would block the holes 22a is relevant and controlling. This proposed modification to the Johnson Patent renders it unsatisfactory for its intended purpose. Consequently, the Johnson Patent teaches away from the proposed modification.

Finally, Examiner argues that the Barnett reference (IPN WO 97/09090) is not "particularly relevant" and "does not provide a teaching away of the claimed subject matter" as Appellant submitted it did. Appellant had submitted:

> "Thus, the Barnett reference teaches one skilled in the art <u>not</u> to use soft material having a durometer value of less than about twenty on the Shore 000 scale in order to maintain some resiliency and structural integrity of the seal. This teaches away from a proposed modification that would replace the surgical rubber tubing in the Johnson patent with a material having a durometer value less than about ten on the Shore 000 scale."
>
> Appellant's Brief, page 7, lines 3-7

Examiner argues:

> "Barnett teaches that it would not be obvious to make the seal as a whole to be of the same resilience as human fat tissue."
>
> Answer, page 4, lines 17-18

As human fat tissue registers a durometer of about 10 on the Shore 000 scale (see Barnett reference, page 11, lines 6-16), Examiner concedes the point Appellant is making. Barnett teaches away from the proposed modification.

Examiner then continues with an argument based on the premise that placing a tube of the requisite durometer rating in the neoprene tube 21 "would not provide a seal as a whole having the claimed durometer...i.e. the durometer of the seal of Johnson, once modified as the examiner contends, would have an overall seal of a durometer higher than that of only the material of tube 22." Answer, page 5, lines 3-5. Examiner has conceded that changing the durometer level of the tube 22 to less than 10 on the Shore 000 scale will not lower the durometer rating of the overall seal to that level. Examiner cannot then argue it would be obvious over the Johnson Patent to use a gel of less than 10 on the Shore 000 scale to arrive at a seal of that durometer level.

Conclusion

In summary, the examiner has erred by improperly relying on the "obvious design choice" rationale and by failing to consider prior art disclosures that teach away from the proposed modification of the Johnson patent. Accordingly, appellant submits that the examiner has failed to establish *prima facie* obviousness with respect to claims 19-29 and submits further that claims 19-29 would not have been obvious over the Johnson Patent.

Please apply any charges not covered, or any credits, to Deposit Account 04-0932 (Reference Number SLP-005).

Respectfully submitted,

Date: 05.24.04

By: _____
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